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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198063
Party	Plaintiff AlpinBreeze LLC
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Attachments	Reply Brief of Opposer.pdf(226830 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board**

AlpinBreeze, LLC,	:	
	:	
Opposer,	:	Opposition No. 91198063
	:	
vs.	:	
	:	
Evertec Information Technology Co., LTD.,	:	Serial No.: 77922346
	:	Mark: ALPINBREEZE and design
Applicant.	:	Published: September 7, 2010
_____	:	

REPLY BRIEF OF OPPOSER ALPINBREEZE, LLC

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PRELIMINARY STATEMENT

Opposer, AlpinBreeze, LLC (hereinafter “Opposer”) provides the instant Reply Brief of the Opposer AlpinBreeze, LLC in support of the instant opposition proceeding. Based upon the submissions of the parties, it is respectfully submitted that the Applicant Evertec Information Technology Co., LTD. (hereinafter “Applicant”) has conceded priority of use in the instant matter. As such, based upon the identical nature of the distinctive logos at issue in conjunction with the identical nature of the products it is submitted to the Board that the Opposer has established priority of use over the Applicant in the United States and, as a result thereof, it is now proper and just to sustain the instant opposition proceeding.

RESPONSE TO MOTION TO STRIKE

To the best of Opposer’s understanding, Applicant has both objected to the manner in which Ms. Ng entered an affidavit of Mr. Sean Lin of Day & Day Trading but has justified its own form of testimony which was, in essence, the same manner in which Mr. Lin’s testimony was provided.

In response, Opposer submits that the affidavit of Mr. Sean Lin was provided within the rules by and through the testimony of Ms. Ng. To the extent his testimony falls outside of the rules, it is submitted that so too does the Applicant’s as it was provided in substantially the same manner as that of Mr. Sean Lin.

STATEMENT OF FACTS

A. Ms. Ng’s First Use of the ALPINBREEZE Logo in the United States

1. In approximately December of 2008 Ms. Ng changed the logo from its original SWISSBREEZE design to the now known ALPINBREEZE Logo. Deposition upon Written Questions of Samanta Ng dated April 17, 2013 (hereinafter “Ng Deposition”) at pp. 13-14.

2. Ms. Ng. hired a professional Swiss graphic Artist, Mark Sonderegger, to transform the SWISSBREEZE logo into the ALPINBREEZE logo. *Id.* at pp. 14–19. *See also* Exhibits 2 - 4 to the Ng Deposition.

3. On or about June 15, 2009 Ms. Ng and Opposer launched alpinbreeze.com to sell her diffuser products under her Opposer’s Trademark. Ng Deposition at p. 22.

4. Since June 15, 2009 to the present the web site alpinbreeze.com has been active permitting purchasers throughout the world, including here in the United States, to order diffusers and other products bearing the Opposer’s Trademark. *Id.* at pp. 22-25. *See also* Exhibits 6-7 to Ng Deposition.

5. In September of 2009, Opposer contracted with H2O At Home Group to sell Opposer’s products bearing the Opposer’s Trademark throughout the United States. Ng Deposition at pp. 29-32. *See also* Exhibit 12 to Ng Deposition.

6. H2O At Home Group placed its first order for Opposer’s products bearing the Opposer’s Trademark on or about October 19, 2009. Ng Deposition at pp. 32-34. *See also* Exhibit 13 of Ng Deposition.

7. Opposer sold approximately 192 diffusers in the United States in 2009 bearing the Opposer’s Trademark. Ng Deposition at p. 34.

B. Applicant’s Alleged First Use of the ALPINEBREEZE Logo

1. By his own admission, Mr. Lin did not file the instant application until January 28, 2010. *See* Cross Examination Questions for the deposition upon Written Questions of Frans Lin, June 25, 2013 (hereinafter “Cross Lin Deposition”) at pp. 2-3. *See also* Ser. No. 77/922,346.

2. Moreover, the Applicant was not using the mark in interstate commerce in the U.S. as evidenced by the filing basis: Section 1(b). *See* Ser. No. 77/922,346.

3. Applicant did not get its first diffuser order from a U.S. customer until December of 2010. Direct Examination Questions for the Deposition upon Written Questions of You-Yi Lin with Exhibits, June 25, 2013 (hereinafter “Lin Deposition”) at p. 9 and Exhibit 11 to Lin Deposition. *See also* Cross Lin Deposition at p. 6.

ARGUMENT

A. Priority

Opposer’s first established its rights in its mark below as early as June 15, 2009 by and through offering for sale its products in the U.S. on its website located at alpinbreeze.com:



Ng Deposition at pp. 22-25. *See also* Exhibits 6-7 to Ng Deposition. In September of 2009, Opposer contracted with H2O At Home Group to sell Opposer’s products bearing the Opposer’s Trademark throughout the United States. Ng Deposition at pp. 29-32. *See also* Exhibit 12 to Ng Deposition. Moreover, H2O At Home Group placed its first order for Opposer’s products bearing the Opposer’s Trademark on or about October 19, 2009. Ng Deposition at pp. 32-34. *See also* Exhibit 13 of Ng Deposition.

As such, Opposer secured rights in its logo in the U.S. no later than October 19, 2009 and, most likely, September of 2009 and possibly as early as June 2009 by offering for sale its diffusers bearing the mark at issue on its website.

In contrast, Applicant's earliest date upon which it can rely is the date of the filing of its intent-to-use application, namely on January 28, 2010. *See* Ser. No. 77/922,346.

Accordingly, by its own concession, Applicant has conceded Applicant retains priority in the instant matter.

B. Alleged Placement of Applicant's Products on Evertec.asia

Applicant contends that it placed the aroma diffuser upon a web site located at Evertec.asia as early as December 2008. It is noted that the timing in Applicant's testimony is confusing at best. Specifically, in regard to this alleged posting Opposer states "The aroma diffuser with alpinbreeze logo was showed on the website on October 13, 2008 right after the logo designer finished the design end of December 2008." *Brief of the Applicant* at ¶ 16. (*emphasis added*) In short, Applicant contends it placed the logo on its website *before* it was created, a feat which is impossible.

Notwithstanding these internal inconsistencies with Applicant's allegations, even assuming, *en arguendo*, Applicant placed a picture of the product bearing the logo at issue on a .asia website, such alone is not sufficient to establish use in the U.S.

First, use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2nd Cir. 1998); *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21.November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006). *See also* *Honda Motor Co., Ltd. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) ("[T]he evidence that applicant relies

upon through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods.)

Second, borrowing from the TMEP § 904.03(i), a web page that displays a product can only constitute use as a “display associated with the goods” if it:

- (1) contains a picture or textual description of the identified goods;
- (2) shows the mark in association with the goods; *and*
- (3) provides a means for ordering the identified goods.

TMEP § 904.03(i) (*emphasis added*). See *In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012); *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); *Lands’ End v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314, 1316 (E.D. Va. 1992).

In this regard, although there is some internally inconsistent testimony that the product possibly appeared on a foreign website in 2008, there is no evidence which would satisfy all three of the requirements of TMEP § 904.03(i), namely that the alleged goods were offered for sale at this time and, moreover, offered to persons in the U.S.

As such, the Applicant has failed to establish priority in 2008 and, accordingly, its earliest priority of use date in the U.S. can only be January 28, 2010, the date of the instant ITU filing.

CONCLUSION

WHEREFORE Opposer reiterates that the evidence before the Board establish all elements necessary to sustain the instant opposition proceeding in its favor. Moreover, now that the matter has been fully briefed, it is submitted that the Applicant has effectively conceded priority in this matter to the Opposer.

Accordingly, the Opposer AlpinBreeze, LLC, by counsel, on the grounds more fully set forth above as well as those previously submitted in connection with Opposer's main trial brief, respectfully requests that the Board find in its favor and sustain the instant opposition against Evertec Information Technology Co., LTD. and its attempt to register the trademark at issue.

Respectfully submitted this 11th day of December, 2013,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 11th day of December, 2013, to be served, by agreement, via electronic mail, upon:

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/Matthew H. Swyers/
Matthew H. Swyers